

## **REMARKS**

1. In response to the Office Action mailed February 24, 2010, Applicants respectfully request reconsideration. Claims 1, 3, 4, 6-14, 17-23 and 26-30 were last presented for examination. In the outstanding Office Action, claims 1, 3, 4, 6-14, 17-23 and 26-30 were rejected. By the foregoing Amendments, claim 1 has been amended and claim 31 has been added. No claims have been cancelled. Upon entry of this paper, claims 1, 3, 4, 6-14, 17-23 and 26-31 will be pending in this application. Of these twenty-five (25) claims, two (2) claims (claims 1 and 31) are independent.
2. Based upon the above Amendments and following Remarks, Applicants respectfully request that all outstanding objections and rejections be reconsidered and withdrawn.

### ***Drawings***

3. Applicants thank the Examiner for indicating that the drawings previously filed in the present application have been accepted. However, the Examiner has accidentally listed an incorrect filing date for the drawings. Specifically, the drawings of the present application were submitted on February 9, 2005, but the Office Action Summary notes that the drawings filed on "19 February 2005" are accepted. Applicants request that the Examiner correct this informality and indicate in the next Office Action that the drawings submitted on February 9, 2005, are accepted.

### ***Applicants' Response submitted December 8, 2009***

4. In Applicants' response submitted on December 8, 2009, Applicants' claim 26 was incorrectly labeled as "Currently Amended." However, no amendments to claim 26 were made in the December 2009 response. Accordingly, claim 26 should have been labeled as "Previously Presented." Claim 26 is correctly labeled in the present response as "Previously Presented."

### ***Claim Rejections under §102***

5. Claims 1, 3, 4, 6-14, 17-23 and 26-30 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent Publication No. 2002/0019669 to Berrang et al. (hereinafter, "Berrang"). Applicants respectfully request reconsideration and withdrawal of these rejections for at least the following reasons.

#### **Claim 1**

6. Berrang is directed to a totally implantable cochlear prosthesis comprising an implanted part 1 having two housing sections 2 and 3 connected by a bridge 6. (*See*, Berrang, paras. [0068]-[0069]; and FIG. 1.) A first housing section 2 includes a battery 18 and a ceramic substrate 24 on which internal components are mounted. (*See*, Berrang, paras. [0077] and [0079]; FIG. 2.) Similarly, the second housing section 3 includes electronics 21 and a ceramic substrate 25 on which the internal components are mounted. (*See*, Berrang, paras. [0077] and [0079]; FIG. 2.)

7. Applicants' claim 1 recites, in part, "a low profile hermetically sealed housing having at least one pliable flange extending outwardly therefrom . . . wherein when the lower surface of the housing is positioned within the well, the at least one flange is bendable by hand so that at least a portion of the at least one flange fits substantially flush against the surface of the bone adjacent the well and is securable to the bone." (*See*, Applicants' claim 1, above; emphasis added.) In the outstanding Office Action, the Examiner appears to equate housing section 3 of Berrang with the "at least one pliable flange" recited in Applicants' claim 1. (*See*, Office Action, pg. 2.) Applicants respectfully disagree with this assertion and submit that housing section 3 of Berrang is not equivalent to a "flange" as would be understood by one of ordinary skill in the art.

8. Applicants respectfully remind the Examiner that §2111 of the Manual of Patent Examining Procedure (MPEP) requires the U.S. Patent and Trademark Office (USPTO) to determine "the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.'" *Phillips v. AWH*

*Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (quoting *In re Am. Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827 (Fed. Cir. 2004)) (emphasis added). Specifically, “[c]laims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their ‘broadest reasonable interpretation’.” *In re Marosi*, 710 F.2d 799, 218 USPQ 289, 292 (Fed. Cir. 1983) (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)) (emphasis in original).

9. Similarly, “[i]n the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art.” (See, MPEP § 2111.01 (III), quoting *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298, 67 USPQ2d 1132, 1136 (Fed. Cir. 2003) (emphasis added). “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” (See, MPEP § 2111.01(III), quoting *Phillips*, 415 F.3d 1303, 1313.)

10. Applicants note that a “flange” is defined as “a flat surface sticking out from an object, which is used to fix it to something or to make it stronger.” (See, Cambridge Dictionary Online, “flange,” <http://dictionary.cambridge.org/british/flange>.) Applicants’ use of the term “flange” in the specification of the present application is consistent with this definition. For example, in relation to an embodiment of the invention, Applicants’ specification discloses a “housing having at least one flange extending outwardly therefrom that is securable and conformable to tissue within the body of the recipient.” (See, Applicants’ Specification, pg. 7, lns. 17-19; emphasis added.)

11. As noted above, Berrang discloses that housing section 3 includes electronics 21 and a ceramic substrate 25 on which the internal components of housing section 3 are mounted. (See, Berrang, paras. [0077] and [0079]; FIG. 2.) Applicants submit that one of ordinary skill in the art would not consider a housing for electronics and other components mounted on a ceramic substrate to be within the ordinary and customary meaning of the term “flange.” Specifically, Berrang’s housing section 3 is not “a flat surface sticking out from an object, which is used to fix it to something or to make it stronger,” but is instead a housing for electronics that is connected to another housing by a bridge. (See, Cambridge Dictionary

Online, “flange,” <http://dictionary.cambridge.org/british/flange>; and see Berrang, para. [0069]; and FIGS. 1 and 2.)

12. Moreover, Applicants’ claim 1 recites, in part, “at least one pliable flange extending outwardly,” and recites “when the lower surface of the housing is positioned within the well, the at least one flange is bendable by hand.” (See, Applicants’ claim 1, above; emphasis added.) Applicants submit that Berrang fails to disclose that housing section 3 is pliable and bendable by hand. Rather, as noted above, Berrang discloses that housing section 3 includes a ceramic substrate 25 on which the internal components of housing section 3 are mounted. (See, Berrang, paras. [0077] and [0079]; FIG. 2.) As is well known in the art, ceramic substrates are brittle and are not “pliable” nor “bendable by hand.” Accordingly, Applicants submit that one of ordinary skill in the art would understand that a housing section 3 containing a brittle ceramic substrate is not equivalent to the “pliable flange” of claim 1. (See, Applicants’ claim 1, above.)

13. It is well recognized that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” (See, MPEP §2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).) The MPEP makes it clear that for a *prima facie* rejection under 35 U.S.C. §102, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” (See, MPEP §2131.01, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989); emphasis added.) For the reasons discussed above, Applicants submit that Berrang’s housing section 3 is not a “pliable flange” wherein the “flange is bendable by hand.” (See, Applicants’ claim 1, above.) Accordingly, Applicants submit that the rejection of claim 1 is *prima facie* improper because the Examiner has failed to show the identical invention as recited in claim 1.

### *New Claim 31*

14. Applicants’ new claim 31 recites, in part, “[a] low profile hermetically sealed housing . . . the housing comprising: at least one pliable flange extending outwardly therefrom, . . . wherein, when the lower surface of the housing is positioned within the well, the at least one flange is conformable by hand so that at least a portion of the at least one flange may be conformed to the surface of the bone adjacent the well and is securable to the bone.” (See, Applicants’ new claim

31, above.) Applicants submit that Berrang fails to anticipate Applicants' new claim 31 at least for reasons similar to those discussed above in relation to Applicants' claim 1. Specifically, Applicants submit that Berrang fails to show "a low profile hermetically sealed housing . . . the housing comprising: at least one pliable flange extending outwardly therefrom, . . . wherein when the lower surface of the housing is positioned within the well, the at least one flange is conformable by hand." (See, Applicants' claim 31, above; emphasis added.) Specifically, Applicants submit that Berrang's housing section 3 is not equivalent to the recited pliable flange that is conformable by hand.

### *Dependent claims*

15. The dependent claims incorporate all the subject matter of their respective independent claims and add additional subject matter which makes them independently patentable over the art of record. Accordingly, Applicants respectfully assert that the dependent claims are also allowable over the art of record.

### *Claim 7*

16. Applicants submit that Applicants' claim 7 is also allowable over Berrang for at least the reasons described above with reference to claim 1. Applicants also assert that claim 7 is allowable over Berrang for at least the following additional reasons.

17. The implanted part 1 of Berrang includes a coil 4 "comprised of a plurality of turns of biocompatible wire 12" and which receives power from an external coil via inductive coupling. (See, Berrang, paras. [0068], [0072], [0083]; Abstract; and FIG. 1.) A corrugated cable 7 including a plurality of wires connects a microphone 9 to housing sections 2 and 3, and a corrugated cable 8 including a plurality of wires connects an electrode array 10 to housing sections 2 and 3. (See, Berrang, paras. [0068] and [0076]; and FIG. 1.) Applicants' claim 7 recites "wherein the housing has at least two flanges extending outwardly therefrom." (See, Applicants' claim 7, above.) In the Office Action, the Examiner equates coil 4 of Berrang with one of the flanges recited in Applicants' claim 7. (See, Office Action, pg. 3.) However, Applicants respectfully assert that coil 4 of Berrang is not equivalent to a "flange" according to the ordinary and customary meaning of the term, and in light of Applicants' specification.

18. As noted above, Berrang discloses that coil 4 includes “a plurality of turns of biocompatible wire” and receives power from an external coil via inductive coupling. (*See*, Berrang, paras. [0072] and [0083]; Abstract; and FIG. 1.) Applicants submit that one or ordinary skill in the art would not consider **a coil of wires that receives power from another coil via inductive coupling** to be within the ordinary and customary meaning of the term “flange”. Berrang’s coil 4 is not “a flat surface sticking out from an object, which is used to fix it to something or to make it stronger,” but is instead an inductive coil that communicates with an external device. (*See*, Cambridge Dictionary Online, “flange,” <http://dictionary.cambridge.org/british/flange>.)

19. In the Office Action, the Examiner also equates each of corrugated cables 7 and 8 of Berrang with one of the flanges recited in Applicants’ claim 7. (*See*, Office Action, pg. 3.) However, Applicants respectfully assert that neither cables 7 nor cable 8 of Berrang is equivalent to a “flange” according to the ordinary and customary meaning of the term, and in light of Applicants’ specification. As noted above, Berrang discloses that cable 7 includes a plurality of wires and connects microphone 9 to housing sections 2 and 3. (*See*, Berrang, paras. [0068] and [0076]; and FIG. 1.) Applicants submit that one or ordinary skill in the art would not consider **a corrugated wire that electrically connects a housing of a hearing prosthesis to a microphone** to be within the ordinary and customary meaning of the term “flange”. Berrang’s cable 7 is not “a flat surface sticking out from an object, which is used to fix it to something or to make it stronger,” but is instead an electrical wire with a corrugated surface that electrically connects different components of a hearing prosthesis. (*See*, Cambridge Dictionary Online, “flange,” <http://dictionary.cambridge.org/british/flange>.)

20. Similarly, as noted above, Berrang discloses that cable 8 includes a plurality of wires and connects electrode array 10 to housing sections 2 and 3. (*See*, Berrang, paras. [0068] and [0076]; and FIG. 1.) Applicants submit that one or ordinary skill in the art would not consider **a corrugated wire that electrically connects a housing of a hearing prosthesis to an electrode array of the hearing prosthesis** to be within the ordinary and customary meaning of the term “flange”. Berrang’s cable 8 is not “a flat surface sticking out from an object, which is used to fix it to something or to make it stronger,” but is instead an electrical wire with a corrugated

surface that electrically connects different components of a hearing prosthesis. (See, Cambridge Dictionary Online, “flange,” <http://dictionary.cambridge.org/british/flange>.)

21. As noted above, Berrang discloses that coil 4 includes “a plurality of turns of biocompatible wire” and receives power from an external coil via inductive coupling. (See, Berrang, paras. [0072] and [0083]; Abstract; and FIG. 1.) Applicants submit that one or ordinary skill in the art would not consider **a coil of wires that receives power from another coil via inductive coupling** to be within the ordinary and customary meaning of the term “flange”. Berrang’s coil 4 is not “a flat surface sticking out from an object, which is used to fix it to something or to make it stronger,” but is instead an inductive coil that communicates with an external device. (See, Cambridge Dictionary Online, “flange,” <http://dictionary.cambridge.org/british/flange>.)

22. As such, for at least these reasons, Applicants submit that Berrang fails to show “wherein the housing has at least two **flanges** extending outwardly therefrom.” (See, Applicants’ claim 7, above; emphasis added.) Accordingly, Applicants submit that the rejection of claim 7 is *prima facie* improper because the Examiner has failed to show the identical invention as recited in claim 7.

### ***Claim 8***

23. Applicants submit that Applicants’ claim 8 is also allowable over Berrang for at least the reasons described above with reference to claim 1. Applicants also assert that claim 8 is allowable over Berrang for at least the following additional reasons.

24. Applicants’ claim 8 recites “wherein the housing has two flanges that extend in substantially opposite directions relative to each other.” (See, Applicants’ claim 8, above.) In the Office Action, the Examiner equates each of Berrang’s coil 4 and corrugated cables 7 and 8 with one of the flanges recited in Applicants’ claim 8. (See, Office Action, pg. 3.) As noted above with reference to claim 7, Applicants submit that neither Berrang’s coil 4, nor Berrang’s cables 7 and 8 are flanges within the ordinary and customary meaning of the term. As such, Applicants respectfully request that the rejection of claim 8 be reconsidered and withdrawn for the same reasons as provided with reference to claim 7.

***Conclusion***

25. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.
26. Applicants reserve the right to pursue any cancelled claims or other subject matter disclosed in this application in a continuation or divisional application. Any cancellations and amendments of above claims, therefore, are not to be construed as an admission regarding the patentability of any claims and Applicants reserve the right to pursue such claims in a continuation or divisional application.

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